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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,812	12/01/2003	Tsutomu Okada	17291	5537

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SCULLY SCOTT MURPHY & PRESSER, PC  
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GARDEN CITY, NY 11530

EXAMINER
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YABUT, DIANE D

ART UNIT	PAPER NUMBER
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3734

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/04/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/724,812

Applicant(s)

OKADA, TSUTOMU

Examiner

Diane Yabut

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 12/1/2003
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on 1 December 2003 is acknowledged submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Claim Objections***

2. The claims are objected to because they include reference characters which are not enclosed within parentheses. Claim 1 line 13 it reads "snare wire 22" and should be --snare wire (22)--.

Reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. See MPEP § 608.01(m).

3. Claim 11 is objected to because of the following informalities: On line 9 of Claim 11 it reads "which the snare where is inserted" and should be --which the snare is inserted--. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by **Chu** (U.S. Patent No. **5,968,056**).

Claim 1: Chu discloses a substantially cylindrical cap **1** having a circular end portion including a holding mechanism which holds an end portion of a snare wire **70** in a loop form, and an attachment portion **5** which attaches the cap to an end portion of an endoscope **25**, wherein the holding mechanism has a plurality of engagement portions **90, 68a-c, 68a'-c'** which are provided in the vicinity of an end edge of the cap and distanced from each other in a circumferential direction, and each engagement portion has an engagement piece and a corresponding portion (on either side of engagement portions) which hold the snare wire therebetween (Figures 1 and 4).

6. Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by **Suzuki** (U.S. Patent No. **6,068,603**).

Claim 12: Suzuki discloses a device for use in combination with an endoscope comprising a substantially cylindrical cap **10**, an attachment portion which attaches the cap to an end portion of an endoscope, and a flexible tube **9** whose end opening communicates with the inner side of the cap, which is arranged outside an insertion

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portion of the endoscope when the cap is attached to the endoscope and used to insert a snare sheath **18** of a high-frequency snare **16** therein, an end portion of a snare wire of the high-frequency snare inserted in the cap through the flexible tube being expanded and arranged in the cap wherein fixing means **23** for fixing the snare sheath of the high-frequency snare so as to be capable of being released is provided in the vicinity of the base end portion of the flexible tube (Figure 1B, col. 6, line 11 to col. 6 line 29, col. 11, lines 4-7).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Chu** (U.S. Patent No. **5,968,056**).

Claims 2, 7, and 8: Chu discloses the claimed device except for the engagement piece and the corresponding portion elastically holding the snare wire therebetween, the engagement piece being able to swivel or bend to a side where the circular end portion is positioned with respect to the corresponding portion and it holds the snare wire between its outer surface and one surface of the corresponding portion when caused to swivel and the snare wire being pressed against the corresponding portion by an elastic return force of the engagement piece. It would have been obvious to one of ordinary

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skill in the art at the time of invention to provide an engagement piece and corresponding portion that elastically hold the snare wire therebetween and the engagement pieces and corresponding portions being able to swivel, depending on the material used to form the cap, such as an elastic, flexible polymer material well known in the art, in Chu since it was known in the art that flexible polymeric materials used in endoscopic caps are biocompatible and allow for greater movement and manipulation of snare wires.

Claim 3: Chu discloses the cap having a cylindrical wall having an end portion constituting the circular end portion and an inner flange (at distal end of **10**) provided so as to inwardly protrude from the end portion of the wall, and each of the engagement pieces is formed so as to be sectioned from the corresponding portion by a pair of vertical notches **90, 68a-c, 68a'-c'** which are distanced at the circular end portion in the circumferential direction and formed at an (unspecified) angle with the circumferential direction (Figure 1).

Claim 4: Chu discloses the each pair of vertical notches **90, 68a-c, 68a'-c'** being formed so as to extend from the end to the base end of the circular end portion (Figure 1).

Claim 5: Chu discloses the inner flange (at distal end of **10**) having a plurality of lateral notches **90, 68a-c, 68a'-c'** extending in the circumferential direction, and each pair of vertical notches extend toward the cylindrical wall from both ends of each lateral notch (Figure 1).

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Claim 6: Chu discloses the circular end portion having a plurality of lateral notches extending in the circumferential direction between the inner flange and the cylindrical wall, and each pair of vertical notches **90, 68a-c, 68a'-c'** extend toward the cylindrical wall from both ends of each lateral notch (Figure 1).

Claim 9: Chu discloses the corresponding portion (on one side of **90, 68a-c, 68a'-c'**) having a flange provided so as to inwardly protrude from the cylindrical wall, the engagement piece (on other side of **90, 68a-c, 68a'-c'**) having separation portions separated from each other by a notch portion formed in the inner flange, and the snare wire is supported between the flange and the separation portions (Figure 1).

Claim 10: Chu discloses the engagement pieces and the corresponding portions (positioned on either side of **90, 68a-c, 68a'-c'**) being alternately arranged in the circumferential direction of the circular end portion (Figure 1).

9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Chu** (U.S. Patent No. **5,968,056**) in view of **Suzuki** (U.S. Patent No. **6,068,603**).

Claim 11: Chu discloses the claimed device except for a snare sheath into which the snare wire is inserted and a flexible tube which has an opening on an end side, the opening communicating with the inner side of the cap, which is arranged outside the insertion portion of the endoscope when the cap is attached to the endoscope, and is used to insert the snare sheath in which the snare is inserted therethrough, wherein fixing means for fixing the snare sheath so as to be capable of being released is provided in the vicinity of a base end portion of the flexible tube.

Suzuki teaches snare sheath **18** into which the snare wire **16** is inserted and a flexible tube **9** which has an opening on an end side, the opening communicating with the inner side of the cap **10**, which is arranged outside the insertion portion of the endoscope when the cap is attached to the endoscope, and is used to insert the snare sheath in which the snare is inserted therethrough, wherein fixing means **23** for fixing the snare sheath so as to be capable of being released is provided in the vicinity of a base end portion of the flexible tube (Figure 1B, col. 6, line 11 to col. 6 line 29, col. 11, lines 4-7). It would have been obvious to one of ordinary skill in the art at the time of invention to provide a snare sheath and flexible tube, as well as a fixing means, as taught by Suzuki, to Chu since it was known in the art that using a sheath effectively protects and guides the snare wire before deployment.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane Yabut whose telephone number is (571) 272-6831. The examiner can normally be reached on M-F: 9AM-4PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on (571) 272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DY

A handwritten signature in black ink, appearing to read "MJ Hayes", with a stylized flourish at the end.

MICHAEL J. HAYES  
SUPERVISORY PATENT EXAMINER